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Docket No.: 549222000101
(PATENT)

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Dated: October 23, 2006

Signature: _____

(Sandy F. H.)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John O. RYAN

Application No.: 08/977,846

Confirmation No.: 3572

Filed: November 25, 1997

Art Unit: 3639

For: METHOD AND SYSTEM FOR
INFORMATION DISSEMINATION WITH
USER MENU INTERFACE (AS AMENDED)

Examiner: T. Dixon

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby requests review of the non-final rejection dated June 7, 2006. A Notice of Appeal is filed herewith as a separate paper. An appeal is in order since claims have been twice rejected. An IDS has been filed October 19, 2006 by facsimile and is entitled to entry, there being no final rejection.

Rejections are Legally and Factually Deficient

Claims 1 and 33-61 are pending and all stand rejected. The two independent claims are apparatus Claim 1 and method Claim 58. Claim 1 stands rejected under § 102 citing DeBey and Lang. Claim 58 stands rejected under § 102 citing Lang. Claims 1 and 58 stand rejected under § 102 citing Yoshio. The remaining (dependent) claims are also rejected as anticipated or obvious.

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DeBey Rejection

The § 102 rejection of Claim 1 citing DeBey is improper and factually wrong, at least because DeBey does not disclose any menu, or any database, or any set of menus, and does not use menus for selecting data from the database, all recited in Claim 1. See Response to Office Action filed March 8, 2006 at page 6, third paragraph. Hence the DeBey rejection is prima facie inadequate.

Further this rejection is legally wrong since the declaration under Rule 132 was not given proper consideration or weight, see the First Declaration under Rule 132 of Charles H. Jablonski, also filed March 8, 2006, paragraphs 4-9 establishing that these features are lacking in DeBey. Mr. Jablonski is an expert in the field, see his Exhibit 1. DeBey only stores part of one program at a time in his memory, or he stores a single data packet of each of several (e.g., 10) separate programs, see First Declaration paragraphs 5-7. Hence he has no reason to have a database. In DeBey there is no menu, no set of menus, no database, and no selecting data from the database using menus, see First Declaration, paragraphs 8-9.

Hence DeBey clearly fails to meet several distinct aspects of Claim 1, see page 6 of March 8, 2006 Response, final two paragraphs. Claim 58 distinguishes over DeBey for at least the same reasons as pertain to Claim 1, though no such rejection was made.

The Examiners' June 7, 2006 rejection ignored the facts established in the First Declaration pertaining to DeBey. This is a legal error since Rule 132 declarations are entitled to consideration as establishing facts attested to therein. The Examiner provided no factual evidence contravening or rebutting the facts established in the First Declaration.

Lang Rejection

The Lang rejection is similarly improper factually and legally, see Applicant's Response of March 8, 2006, page 7. Lang is deficient in essentially the same ways as DeBey, see the First Declaration, paragraphs 12-14 so this rejection is also prima facie inadequate.

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As established in the First Declaration, paragraph 12, the Lang device is an improved video cassette recorder (VCR). Lang does not disclose a menu describing a database, much less a set of menus, see First Declaration, paragraph 13. There is a single appearance of the term "menu" in Lang at col. 6, lines 63-68. However, this is not a menu that describes the content of stored data. Instead, Lang merely provides a display (described by him as a "menu") which shows a list of desired "frame numbers" stored on the VCR tape, see First Declaration, paragraph 12. There is no similarity between Lang's display of "frame numbers" and the menus recited in the present claims. The "Frame numbers" displayed in Lang are not a list of items descriptive of the content of the database, any more than a list of the page numbers of a book indicates what is written on them. Instead, the Lang frame numbers merely designate frames (individual video images) of a particular stored video program. Further, Lang does not describe how the stored video program segments themselves are identified in his system.

Hence in Lang there is no database, no menu to select data, no set of menus, and no selecting data from the database using menus, all in the claims, see First Declaration, paragraph 13. Thus Lang does not meet the claims, see First Declaration, paragraph 14.

The Examiner ignored the facts established in the First Declaration as pertain to Lang. This is a legal error similar to that committed by the Examiner with respect to the DeBey rejection.

Yoshio Rejection

Yoshio (also referred to as "Yoshio et al" and "Yoshiro et al".) is not enabling of the claimed invention and hence as a matter of law cannot support a § 102 rejection, see Applicant's March 8, 2006 Response at page 8 carrying over to page 9. See also the Second Declaration under Rule 132 of Charles H. Jablonski at paragraphs 3, 4, 5 and 6. The Examiner ignored this Second Declaration, and also ignored the legal significance of a reference not being enabling and hence not anticipatory. Thus he made a factual error in regards to Yoshio being non-enabling and a legal error in not considering the Second Declaration.

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Yoshio does not anticipate the claims as a matter of law because, inter alia, Yoshio is not an enabling disclosure of the claimed invention, see the Second Declaration, paragraphs 3, 4, 6 and 7. Yoshio is a published unexamined Japanese patent application (Kokai), see Second Declaration, paragraph 5. Japanese patent attorneys representing the assignee of this application verified that the Yoshio application was never examined. In Japan a request for examination must be filed by the applicant, or the application is not examined. According to the Japanese Patent Office database, the Yoshio application was never examined and is deemed to have been withdrawn. No official action was ever issued nor any response filed. It is a matter of public record (hence Official Notice must be taken) that no patent in Japan or elsewhere ever issued from or claiming priority to Yoshio. Clearly, no patent will ever issue from the Yoshio application now, due to the passage of time. It is believed that no non-Japanese counterpart applications to Yoshio were ever filed.

The Examiner ignored all this. As a matter of case law, see Applicant's March 8, 2006 Response, bottom of page 8 to page 9, lack of enablement in a reference means that the reference is not able to defeat novelty, that is anticipate. Yoshio, not being an issued patent, enjoys no presumption of enablement or validity or operability, see page 9 of March 8, 2006 Response, second to last paragraph carrying over to page 10.

Even if Yoshio was regarded as enabling of the invention by the Examiner, Applicant rebutted his understanding by the facts established in the Second Declaration, see bottom of page 9 carrying over to page 10 of Applicant's March 8, 2006 Response.

The Yoshio disclosure, as one can tell by reading it, is limited to the user functionality, and does not describe how any actual apparatus is built or operates or its internal structure. The Second Declaration establishes that the disclosure of Yoshio's apparatus is more a wish list of desired functionality than enabling of any actual apparatus much less the claimed invention, see Second Declaration, paragraph 6. This is also apparent to anyone reviewing Yoshio.

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Obviousness

The Examiner did not reject Claims 1 or 58 as being obvious. However, it is respectfully submitted that the claims distinguish over the cited references even in combination with the other cited references.

Conclusion

Independent Claims 1 and 58 are not anticipated by the cited references and allowable thereover. It is respectfully requested that all the rejections be reconsidered and withdrawn or reversed. No arguments are made here regarding dependent claims. This is not to concede such claims are other than patentable on their own, but only to simplify issues for the panel review. It is understand there is no fee for this Request, but the USPTO is authorized to charge deposit account no. 03-1952 referencing docket no. 549222000101 for any amounts due.

Dated: October 23, 2006

Respectfully submitted,

By 

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